

**R E M A R K S**

**I.      Introduction**

In response to the Office Action dated December 24, 2008, Applicants have amended claims 1 and 4 in order to further clarify the present disclosure. In addition, new claims 6-11 have been added. Support for the amendments to claims 1 and 4 may be found, for example, on page 5, lines 11-13 of the specification. Support for new claims 6-11 may be found, for example, in Figs. 3-7 of the drawing. No new matter has been added.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

**II.     The Rejection Of Claims 1 And 4 Under 35 U.S.C. § 103**

Claims 1 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Yutaka (JP 2002/137225) in view of Akio (JP 2001/089021). Applicants respectfully traverse this rejection of the pending claims for at least the following reasons.

With regard to the present disclosure, amended independent claims 1 and 4 each recite a method or apparatus for removing a dissimilar material in which the dissimilar material is punched out by moving a blade unit down from an upper position relative to a seat unit with a working unit located lower than the seat unit and the blade unit.

Yatuka teaches a method and apparatus for removing dissimilar material from a plastic product. It is admitted that the working unit of Yatuka is not located lower than the seat unit and the blade unit. Akio is relied upon to remedy this deficiency. Applicants respectfully traverse this rejection.

Foremost, Akio is directed toward a device and method for peeling adhesive from the surface of a cabinet. It utilizes heat for heating the adhesive until it becomes viscous, wherein the adhesive is then removed. As such, Akio is, contrary to the Examiner's allegation, not the same field of endeavor as that of Yutaka, in which dissimilar plastic material is punched out from a plastic product.

Furthermore, Akio shows, in Fig. 3, a control part 14 (the alleged "working part") which is located near the base board 11. This control part 14 simply controls the temperature of the heating part 13. As such, it does not perform "work" as understood in the present disclosure, which is causing the blade unit to move downward to punch out the dissimilar plastic material.

Moreover, if the working unit of Yutaka were placed at the base of the apparatus of Akio, the invention of Akio, which heats the adhesive, would be rendered inoperative, because the working unit of Yutaka does not control a heater, but causes the blade unit to operate. Moreover, the same is true for the working unit of Akio applied to the apparatus of Yutaka for reciprocal reasons. As is well known in patent law, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As the working unit of Yutaka would render the peeling device of Akio inoperable for its intended purpose, and *vice versa*, there is no suggestion or motivation to make the proposed combination of Yutaka with Akio. Accordingly, Applicants respectfully submit that the § 103 rejection of claims 1 and 4 over Yutaka and Akio.

Furthermore, assuming *arguendo* that the working unit of Yutaka *could* be used in Akio, the combination would still fail to disclose the limitations of claims 1 and 4 of the present

disclosure. If the working unit of Yutaka were placed at the base of the apparatus of Akio, the working unit of Yutaka, which includes the seat unit and punching unit would be arranged upside down. As a result, although the working unit would be arranged lower than the blade unit, the blade unit would move in a direction away from the working unit to punch out the dissimilar material. Thus, the working unit would move the blade up from a lower position than the seat unit. As such, the proposed combination of Akio and Yutaka would not teach or suggest the limitations of amended claims 1 and 4 of a moving a blade unit down from an upper position relative to a seat unit with a working unit located lower than the seat unit and the blade unit.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. As is clearly shown, the Akio and Yutaka do not disclose a step of moving a blade unit down from an upper position relative to a seat unit with a working unit located lower than the seat unit and the blade unit, OR a working unit located lower than the seat unit and the blade unit and configured to move the blade unit down from an upper position relative to the seat unit. Accordingly, Applicant submits that Akio and Yutaka do not render claims 1 and 4 of the present disclosure obvious and as such, claims 1 and 4 are patentable and allowable over the cited prior art. Accordingly, Applicant respectfully requests that the § 103(a) rejection of claims 1 and 4 be withdrawn.

**III. All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable**

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1 and 4 are patentable for the

reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance. As such, Applicant respectfully submits that the new claims 6-11 are allowable over the cited prior art.

In addition, as the Akio and Yutaka fail to disclose the elements of new claims 6-11 (a first or second guide unit, a second collection box, or that the first and second guide units and the working unit are aligned in the horizontal direction), claims 6-11 are allowable for at least these reasons as well.

**IV. Conclusion**

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication of which is respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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